

REMARKS

Claims 1,2 and 16-42 were pending.

Claims 1,2 and 16-42 are subject to a restriction requirement.

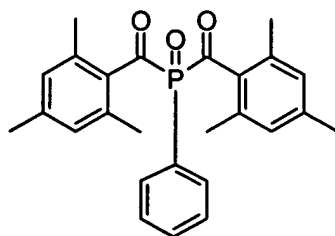
The Applicants confirm that claim 16 is cancelled.

Claims 1,2 and 17-42 are pending.

A restriction is required under 35 U.S.C. 121 and 372. Examiner asserts that the application contains LX separate groups all being of different processes for making structurally different compounds by using structurally different starting materials which require various different chemical requirements including having a catalyst or not having a catalyst, having an alkali metal reagent or a magnesium reagent. The Examiner further asserts that these groups are not linked so as to form a single general inventive concept under PCT Rule 13.1. Therefore, Examiner has requested the Applicants must elect a single invention to which the claims must be restricted.

The Applicants elect with traverse Group XXVII. Group XXVII reads on claims 2, 30, 31, 32, 33, 34, 35, 36, 37, 38, 40, 41, 42(in part) are drawn to the preparation of P(V) phosphine oxide wherein there is one phosphorus in the phosphine oxide, $n=1$ and $m=2$. R1 and R2 are not a heterocyclic rings. The acyl phosphine is formed by reacting a compound of formula II with a compound of formula III without isolating the intermediates. The reaction contains an alkali metal or mixtures thereof but no magnesium and with a catalyst.

The ultimate species selection is taken from example 1, bis(2,4,6-trimethylbenzoyl)phenylphosphine oxide. Li is used as a metal, together with a catalyst.



The Applicants respectfully traverses the restriction requirement for the reasons below.

Rule 13.2

Rule 13.2

...Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

MPEP 1850 E.

Unity of invention shall be considered to be present in the context of intermediate and final products

Where the following two conditions are fulfilled:

- A) The intermediate or starting products have the same essential structural element, in that:
 - a. The basic chemical structures of the intermediate and the final products are the same, or
 - b. The chemical structures of the two products are technically closely interrelated, the intermediate incorporating an essential structural element into the final product; and
- B) The intermediate and final products are technically interrelated, this meaning that the final product is manufactured directly from the intermediate or is separated from it by a small number of intermediates all containing the same essential structural element.

In the present case, the products formed in claims 1 and 2 are closely related containing the "same essential structural element" acyl phosphines, or acyl phosphine oxides or sulfides. The product of claim 1 is clearly the starting material or intermediate in the formation of the acyl phosphine oxide ($Z=O$) and the acyl phosphine sulfide ($Z=S$) of claim 2. The technical relationship of the phosphine oxide and phosphine sulfide compounds is their photoinitiating property. All claimed final products are photoinitiators, while the corresponding phosphines are technically linked to the products as intermediates, by which the photoinitiators can be directly made.

Concerning the variations in the process for the preparation, i.e. using an alkali metal or alkali metal together with magnesium, performing the process with or without a catalyst, are to be considered corresponding technical features, i.e. the process according to the invention can be worked with all those alternatives to give the same result: the photoinitiators of formula IV and their intermediates of formula I.

The present Applications also fulfill the criteria for unity of invention for Markush structures alternative also governed by PCT Rule 13.2. When the Markush grouping is for alternatives of chemical compounds, they shall be regarded as being of a similar nature where the following criteria are fulfilled:

- A) all alternatives have a common property or activity;

The product in claim 1 is an intermediate for the acylphosphine oxides or sulfides of claim 2 which will ultimately be used as a photoinitiator.

B) A common structure is present, i.e., a significant structural element is shared by all of the alternatives.

The product in claim 1 is an acylphosphine. The product of claim 2 is an acylphosphine oxide or sulfide. The acylphosphine oxide is formed from the acylphosphine.

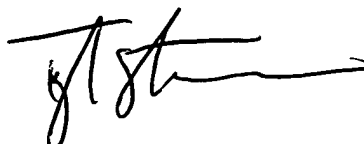
This application has already been examined according to PCT unity of invention criteria. The PCT Examiner and Search Authority did not identify multiple inventions within the instant application. Accordingly, this is a clear indication that the present claims fulfill the requirements according to Rule 13 PCT.

The Applicants asks that the Examiner withdraw the multiple, economically extremely burdensome election requirements in light of the arguments above.

The Applicants respectfully submits that the instant application is ready to be examined on the merits.

In the event that minor amendments will further prosecution, Applicants request that the examiner contact the undersigned representative.

Respectfully submitted,



Tyler Stevenson
Agent for Applicants
Reg. No. 46,388

Ciba Specialty Chemicals Corporation
540 White Plains Road
Tarrytown, New York 10591
(914) 785-2783
SAL/21884_elect.doc

Enclosure: 1 month Petition for Extension

SEP 05 2003